

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNESTO COHEN

Application 10/666,439
Technology Center 3600

MAILED

JUN 20 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on June 9, 2007. A review has revealed that the application is not ready for docketing as an appeal. Accordingly, this application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below:

Appellant filed an Appeal Brief which was received by the USPTO on September 21, 2005. The content listed under the heading "SUMMARY OF CLAIMED SUBJECT MATTER" does not provide a concise explanation of the subject matter defined in the independent claim involved in the appeal.

37 C.F.R. § 41.37(c)(1)(v) requires the Appellant must provide a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. § 112, sixth

paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The Appeal Brief must map the independent claims to the Specification consistent with the quotation above. It is imperative that a revised "SUMMARY OF CLAIMED SUBJECT MATTER" be submitted that clearly maps independent claim 1 and any dependent claimed argued separately to the Specification by page and line number. Correction is required. *The Manual of Patent Examining Procedure (MPEP)* § 1205.03 states:

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

Further review has revealed that on July 21, 2006, an Examiner's Answer was entered into the record. In the Evidence Relied Upon section, page no. 3, paragraph 8, the Examiner has stated that "No evidence is relied upon by the [E]xaminer in the rejection of the claims under appeal." A review of the Examiner's Answer reveals that references to Cook (3371957) and Riley (5722723) were applied to the statement of rejections in the Grounds of Rejection, paragraph (9) of the Examiner's Answer.

Before further review, the Examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of references mentioned in the statement of rejections. *See MPEP* § 1207.02.

Accordingly, it is *ORDERED* that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on September 21, 2005, defective;
- 2) to notify Appellants to file a paper providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v);
- 3) to consider the paper providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v);
- 4) to issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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PJN/hh